



Patent
Attorney's Docket No. 032505-010

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| In re Patent Application of |) | |
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| Graeme COX <i>et al.</i> |) | Group Art Unit: 1617 |
| |) | |
| Application No.: 09/807,277 |) | Examiner: Shengjun Wang |
| |) | |
| Filed: March 1, 2002 |) | Confirmation No.: 6035 |
| |) | |
| For: A METHOD OF MODULATING |) | |
| ION CHANNEL FUNCTIONAL |) | |
| ACTIVITY |) | |

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Response is timely filed in complete response to the Office Action mailed on November 14, 2003 (Paper No. 13) (November 14, 2003 was a Sunday), and further to the Office Action (restriction requirement) of March 26, 2003.

The Examiner has required the election of a single compound. Applicants hereby elect, with traverse, the compound HMA. It is believed that claims 1-9, 12-20, 22-27, 30-34, 37-41, 44-47, and 50-54 are readable upon the elected species as defined above.

Applicants respectfully traverse the restriction requirement as set forth in the Office Action. Applicants respectfully submit that the species HMA and DMA should properly be examined together. These species are closely related and so a proper search of one species should, by necessity, require a proper search of the other.

Specifically, Applicants submit that HMA (5-(N,N-hexamethylene)-amiloride) and DMA (5-(N,N-dimethyl)-amiloride) are both closely related derivatives of amiloride. As both are amiloride derivatives where the H₂N group at the 5 position of the pyrazine has been substituted, both compounds inhibit Vpu function and thus inhibit the

continuation of the HIV life cycle. Applicants submit that all of the species can be searched simultaneously, and that a duplicative search, with possibly inconsistent results, may occur if the restriction requirement is maintained. Applicants submit that any nominal burden placed upon the Examiner to search accordingly to determine the art relevant to Applicants' overall invention is significantly outweighed by the public's interest in not having to obtain and study many separate patents in order to have available all of the issued patent claims covering Applicants' invention.

In light of the statement within the Office Action that "... upon allowance of a generic claim Applicants will be entitled to consideration of claims to additional species", the Examiner is reminded of *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) in which the court articulated the general proposition that:

[A]n applicant has a right to have *each* claim examined on the merits. If an applicant submits a number of claims, it may well be that pursuant to a proper restriction requirement, those claims will be dispersed to a number of applications. Such action would not affect the right of the applicant eventually to have each of the claims examined in the form he considers to best define his invention. If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on its merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the subgenera would be defined by the examiner rather than by the applicant, it is not inconceivable that a number of the fragments would not be described in the specification. *Id.* at 331 (Emphasis in original).

According to the general policy as articulated in the MPEP, "since the decisions in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334, it is *improper* for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. *In re Harnish*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and *Ex parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984)." (MPEP 803.02, emphasis added).

As such, Applicants expressly reserve the right to traverse any subsequent divisions made by the Examiner of the present invention into "inventive groups" following the present provisional election of one species for examination.